



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,264	03/23/2001	Susan Bumgardner Cirulli	END9 2000 0177 US1	7299
44755	7590	08/11/2005	EXAMINER	
SHELLEY M. BECKSTRAND 61 GLENMONT ROAD WOODLAWN, VA 24381			APPLE, KIRSTEN SACHWITZ	
			ART UNIT	PAPER NUMBER
			3628	
DATE MAILED: 08/11/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,264

Applicant(s)

CIRULLI ET AL.

Examiner

Kirsten S. Apple

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

This action is in response to the application filed on 03/23/2001.

Priority

No claim for priority has been made in this application.

Drawings

There are no objections to the drawings.

Specification

The attempt to incorporate subject matter into this application by reference to assignee docket number is improper because these references do not formally identify the documents. [see page 2-4] Proper identification of references, such as the serial numbers, is required. See MPEP 608.01.

The disclosure is objected to because of the following informalities:

- 1) "Req/Cat." is unclear and needs to be defined [page 11, line 4]
- 2) "SAP" is unclear and needs to be defined [page 11, line 15]
- 3) Missing S/N [page 12, line 17]
- 4) Add "field 122" to item "tax jurisdiction code" [page 14, line 22]

This Appropriate correction is required for items listed above.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 3628

Claim 1-5 and 12 are rejected under 35 U.S.C. 101 because as a method claim they "lack technology knowledge." None of these method claims include a computer or process, which must be employed in order to complete the method.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

- 1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result,
AND
- 2) The claim provides a limitation in the technological arts that enables a useful, concrete, tangible result.

As to the technology requirement, note MPEP Section IV 2(b). Also note *In re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches "useful arts" is synonymous with "technological arts". In *Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartoli et al. U.S. Patent 6,047,268 (herein referred to as Bartoli) in view of USBI bill and company information (herein referred to as USBI, see List of Referenced Sites and attached bill provided by Examiner.)

Re claim 1, 6, 11 and 12: Bartoli discloses:

A method for purchases (see Bartoli column 2, line 28 "billing system"), comprising the steps of:

receiving from a user, identified by company indicia to one of a plurality of company groups (see Bartoli column 3, line 27 "users account"), a purchase requisition for a service or commodity object (see Bartoli FIG 2B, Item B211 "billing request");

responsive to said indicia and said object, determining in a front end process, a tax location (see Bartoli, column 4, line 44 "address") based on defined business rules;

feeding said tax location code to a back end process (see Bartoli, column 4, line 64 "for later retrieval); and

in said back end process, preparing a purchase order identified to said one of said plurality of company groups for transmittal to a supplier of said object (see Bartoli FIG 2B, Item B211 "process billing request")

Although Bartoli does not have explicitly disclose "assigning tax codes" and "converting said tax code and tax location to a tax jurisdiction code with associated tax rate." It is obvious to one of ordinary skill in the art to "process the billing request" tax would have to be calculated. In addition, USBI is an example of a company which has been doing this since 1993. USBI is a clearinghouse company for the telecommunication industry and has been calculating "associated tax rates" in accordance with "business rules" both for on and off-line billing. Enclosed is some information about USBI in addition to a bill from July 22, 1998 with the associated tax calculated by USBI.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to explicitly add the "tax rate calculation" step as taught in by USBI to Bartoli billing over the internet. It is clear that any third-party billing provided would be motivated to provide "tax rate calculation" to have a complete billing solution and minimize the step for their customers.

The method claim 1 is similar to the system claim 6, device claim 11 and program claim 12. It would be obvious to one of ordinary skill in the art that these claim have similar limitation. Therefore, claim 6, 11 and 12 are rejected based on the information provided regarding claim 1.

Re claim 2 and 7: Bartoli discloses:

The method comprising the steps of:

receiving an invoice from said supplier (see Bartoli FIG 2B, Item B211 "billing request");

responsive to said company group from said purchase order, processing said invoice to selectively pay, short pay, or reject said invoice (see Bartoli FIG 2B, Item B211 "process billing request").

Although Bartoli does not have explicitly disclose "*tax field*" and "*tax code.*" It is obvious to one of ordinary skill in the art to "process the billing request" tax would have to be calculated. In addition, USBI is an example of a company, which has been calculating tax as a third party billing company since 1993.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to explicitly add the "tax rate calculation" step as taught in by

Art Unit: 3628

USBI to Bartoli billing over the internet. It is clear that any third-party billing provided would be motivated to provide "tax rate calculation" to have a complete billing solution and minimize the step for their customers.

The method claim 2 is similar to the system claim 7. It would be obvious to one of ordinary skill in the art that these claim have similar limitation. Therefore, claim 7 is rejected based on the information provided regarding claim 2.

Re claim 3 and 8: Bartoli discloses:

The method comprising the steps of:

receiving from said user and tax location indicia (see Bartoli, column 4, line 44 "address").

Although Bartoli does not have explicitly disclose "*tax field*" and "*defining taxability for said object based on defined business rules.*" It is obvious to one of ordinary skill in the art to "process the billing request" tax would have to be calculated. In addition, USBI is an example of a company, which has been calculating tax as a third party billing company since 1993.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to explicitly add the "tax rate calculation" step as taught in by USBI to Bartoli billing over the internet. It is clear that any third-party billing provided would be motivated to provide "tax rate calculation" to have a complete billing solution and minimize the step for their customers.

The method claim 3 is similar to the system claim 8. It would be obvious to one of ordinary skill in the art that these claim have similar limitation. Therefore, claim 8 is rejected based on the information provided regarding claim 3.

Re claim 4 and 9: Bartoli discloses:

The method for billing transactions over the internet.

Although Bartoli does not have explicitly disclose "*providing each object with a tax code*" and "*defining taxability with reference to corresponding tax code.*" It is obvious to one of ordinary skill in the art to "process the billing request" tax would have to be calculated. In addition, USBI is an example of a company, which has been calculating tax as a third party billing company since 1993.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to explicitly add the "tax rate calculation" step as taught in by USBI to Bartoli billing over the internet. It is clear that any third-party billing provided would be motivated to provide "tax rate calculation" to have a complete billing solution and minimize the step for their customers.

The method claim 4 is similar to the system claim 9. It would be obvious to one of ordinary skill in the art that these claim have similar limitation. Therefore, claim 9 is rejected based on the information provided regarding claim 4.

Re claim 5 and 10: Bartoli discloses:

The method for billing transactions over the internet.

Although Bartoli does not have explicitly disclose "*maintaining, obtaining and defining taxability table from tax code.*" It is obvious to one of ordinary skill in the art to

Art Unit: 3628

"process the billing request" tax would have to be calculated. In addition, USBI is an example of a company, which has been calculating tax as a third party billing company since 1993.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to explicitly add the "tax rate calculation" step as taught in by USBI to Bartoli billing over the internet. It is clear that any third-party billing provided would be motivated to provide "tax rate calculation" to have a complete billing solution and minimize the step for their customers.

The method claim 5 is similar to the system claim 10. It would be obvious to one of ordinary skill in the art that these claim have similar limitation. Therefore, claim 10 is rejected based on the information provided regarding claim 5.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on 571.272.6799. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa

[Handwritten Signature]
Patent Examiner
Au 3628